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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,814	11/24/2003	Francisco Martinez de Velasco Cortina	3788-010-27	3467
23562	7590	09/29/2005	EXAMINER	
BAKER & MCKENZIE PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201			LIEU, JULIE BICHNGOC	
			ART UNIT	PAPER NUMBER
			2636	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/718,814	DE VELASCO CORTINA, FRANCISCO MARTINEZ	
	Examiner	Art Unit	
	Julie Lieu	2636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/16/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office action is in response to Applicant's election filed July 28, 2005 in response to restriction requirements. Group I consisting claims 1-16 has been elected.

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/118,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of claims 1-6 include limitations similar to claims 1-3 of '092; the combination of claims 7-10 include limitations similar to claims 1-3 of '092; the combination of claims 11-13 include limitations similar to claims 1-3 of

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'092; the combination of claims 14-15 include limitations similar to claims 1-3 of '092; and claim 16 includes limitation similar to claim 1 of '092.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Drawings***

4. The drawings are objected to because figure 4 is not clear. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-3, 5, 7, 8, 11, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Look (US Patent No. 6,894,615).

Claim 1:

Refer to figure 2, Look discloses a radio frequency device comprising:

- a. at least one metallized region 112;
- b. at least one non-metallized region beneath 114,
- c. at least one antenna (inherently in connection with RFID device 114) on the at least one non-metallized region;

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d. at least one radio frequency chip 114 in communication with the at least one antenna; and

e. at least one connector connecting the at least one antenna to the at least one metallized region (see fig. 1)

Claim 2:

The device in Look comprises at least one base layer 115.

Claim 3:

The RF device in Look has at least one metallized region disposed on the at least one base layer 115.

Claim 5:

The device in Look includes at least one holographic image. Col. 6, line 66 to col. 7, line 3.

Claim 7:

Refer to figure 2, Look discloses a radio frequency device comprising:

- a. at least one base layer 115
- b. at least one metallized region 112;
- c. at least one non-metallized region beneath 114,
- d. at least one antenna (inherently in connection with RFID device 114) on the at least one non-metallized region;
- e. at least one radio frequency chip 114 in communications with the at least one antenna; and
- f. at least one connector connecting the at least one antenna to the at least one

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metallized region (see fig. 1)

Claim 8:

The device in Look includes at least one holographic image. Col. 6, line 66 to col. 7, line

3.

Claim 11:

Refer to figure 2, Look discloses a radio frequency device comprising:

- a. at least one base layer 115
- b. at least one metallized region 112;
- c. at least one non-metallized region beneath 114,
- d. at least one holographic image. Col. 6, line 66 to col. 7, line 3.
- e. at least one antenna (inherently in connection with RFID device 114) on the at least one non-metallized region;
- f. at least one radio frequency chip 114 in communications with the at least one antenna; and
- g. at least one connector connecting the at least one antenna to the at least one metallized region (see fig. 1)

Claim 14:

Refer to figure 2, Look discloses a radio frequency device comprising:

- a. at least one base layer 115
- b. at least one metallized region 112;
- c. at least one non-metallized region beneath 114,
- d. at least one holographic image (col. 6, line 66 to col. 7, line 3)

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- e. at least one antenna (inherently in connection with RFID device 114) on the at least one non-metallized region;
- f. at least one radio frequency chip 114 in communications with the at least one antenna; and
- g. at least one connector connecting the at least one antenna to the at least one metallized region (see fig. 1)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



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8. Claims 4, 6, 9, 10, 12, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Look (US Patent No. 6,894,615).

Claims 4, 10, 13, and 15:

It is not clear whether the non-metallized region in Look is created by demetallizing a portion of the at least one metallized region, though the reference suggests the metallized region and the non-metallized region residing on the same substrate. Lacking any criticality why a non-metallized region must be formed by demetallized portion of the metallized region, it appears that the non-metallized region functions equally well as if it were demetallized from a metallized region.

Claims 6, 9, and 12:

In one of the example in Look, namely figure 8, a holographic image is formed in the non-metallized region. Thus, one skilled in the art would have readily recognized placing a holographic image over the tag to provide indication and to secure the tag on the mounting surface.

Claim 16:

Refer to figure 2, Look discloses a radio frequency device comprising:

- a. at least one base layer 115
- b. at least one metallized region 112;
- c. at least one non-metallized region beneath 114,
- d. at least one holographic image. Col. 6, line 66 to col. 7, line 3.
- e. at least one antenna (inherently in connection with RFID device 114) on the at least one non-metallized region;

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- f. at least one radio frequency chip in communications with the at least one antenna;
- g. at least one connector connecting the at least one antenna to the at least one metallized region (see fig. 1).

It is not clear whether the non-metallized region in Look is created by demetallizing a portion of the at least one metallized region, though the reference suggests the metallized region and the non-metallized region residing on the same substrate. Lacking any criticality why a non-metallized region must be formed by demetallized portion of the metallized region, it appears that the non-metallized region functions equally well as if it were demoralized from a metallized region.

9. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over US 20020160786 (Appl. 10/118,092).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 571-272-2978. The examiner can normally be reached on MaxiFlex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie Lieu  
Primary Examiner  
Art Unit 2636

Sept. 24, 05